

REMARKS

Reconsideration of this application in light of the present amendment and remarks is respectfully requested.

Claims 1-34 have been rejected.

Claims 1 and 15 were objected to. Appropriate correction has been provided.

Claims 1, 4, 5, 10-12, 14, 15, 17, 18, 25 and 27-29 have been amended.

Claims 1-34 are pending in this application.

Formal Matters

Claims 1, 4, 5, 14, 15, 17, 18, 25 and 27-29 have been amended to clarify the "frequency of updates" is actually a "frequency of measurement updates" and therefore claims 1, 15 and 27 provide the proper antecedent basis.

Claims 1, 15 and 27 have been amended to delete the duplicate "the" term.

Claims 10-12 have been amended to replace "the" with "an" as suggested by the Examiner.

The "frequency" term of claims 1, 4, 5, 14, 15, 17, 18, 25 and 27-29 is properly interpreted as "how often measurements are updated", as confirmed by the Examiner.

Substantive Matters

Claims 1-4, 6, 13, 15-17, 24, 27-28 and 34 have been rejected under 35 U.S.C. §102(b) as being anticipated by Menich et al. (US 5327575 "Menich"). This rejection is respectfully traversed.

The Examiner states that the timing advance of Menich affects how fast it takes to communicate, and therefore describes how often measurements are updated (i.e. the frequency of measurement updates, as recited in applicants' claim 1). Applicant submits that these two concepts are completely different.

As is known in the art, timing advance is effectively a speed-of-light correction to synchronize signals propagating from a distant cell compared to a closer cell (e.g. microseconds). Applicants respectfully disagree that a speed-of-light correction is the same as how often measurements are updated by a subscriber unit. Applicants agree that the speed-of-light is an upper limit for communications, but then the speed-of-light is an upper limit for everything. The measurement updates in applicants invention can only be communicated during one information frame for the communication protocol being used by the system, and is not related to the speed-of light. Instead the frequency of measurement update is how often an update message is sent within a number of frames.

Applicants submit that the previous language of the claims may have been confusing in this regard, wherein the term "frequency of updates" could have been confused with the carrier frequency of the signal sending the updates and not the number of update messages themselves that are sent to the base station, as is meant in the amended claims. At its fastest, a measurement updates could only be sent once per frame (e.g. milliseconds), which does not compare with the carrier frequency (e.g. microseconds). Further, the carrier frequency (or timing advance) is effectively static, whereas the frequency of measurement updates can vary greatly depending upon how busy each element of the system is. Further support for this can be found in the specification on page 12 lines 16-24. Moreover, the updates are measured dynamically, support for which can be found on page 13 lines 3 to 6.

Therefore, applicants submit that the claims as amended clarify this misconception of "frequency" and that the claims be reconsidered in this light.

The Examiner goes on to state that Menich discloses selecting a subset of carriers in response to the timing advance. Applicants have provided a distinction between timing advance and frequency of measurement updates above. Further, applicants respectfully submit that Menich does not disclose selecting a subset of carriers in response to either of the above. Menich discloses modifying the complete list of nearby base stations (abstract and col. 4 lines 44-63) instead of only selecting certain carriers from the list leaving the full list intact, as reflected in applicants' invention.

Therefore, applicants respectfully submit that Menich is missing the elements of "frequency of measurement updates" and selecting a "subset of carriers dependent upon the frequency of measurement updates".

The above arguments with respect to claim 1 are also applicable to amended independent claims 15 and 27.

As a result, applicants respectfully submit that that amended claims 1, 15 and 27 are patentable and non-obvious over Menich.

Claims 2-14, 16-26, and 28-34 are dependent on amended claims 1, 15, and 27, respectively, and therefore include all of the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed patentable and non-obvious as well for the same reasons.

Therefore, applicants respectfully request that this rejection be withdrawn.

Claims 5-10, 14, 18-22 and 29-33 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Menich in view of ETSI TR 125 922 v3.4.0 2000-12 (hereinafter "3GPP2000"). This rejection is respectfully traversed.

Claims 5, 10 and 14 have been amended to properly follow from amended claim 1.

Claim 18 has been amended to properly follow from amended claim 15.

Claim 29 has been amended to properly follow from amended claim 27

Menich has been distinguished previously, and the above arguments concerning Menich are hereby incorporated by reference.

3GPP2000 discloses that the time needed to perform measurements is based on whether a single-mode user can operate in compressed mode (p.19 sec. 5.1.6.2.1.1). Therefore, it may be implied that measurements are based on whether a single-mode subscriber has the capability of operation in compressed mode. 3GPP2000 is not interested in using dual-mode capabilities as in applicants' invention (see 5.1.5.1 second paragraph), but instead is interested in changing measurement timing using compressed mode for a single-mode user. Therefore, 3GPP2000 teaches away from applicants' invention. In addition, 3GPP2000 does not select a *subset* of carrier frequencies to monitor base upon capability but instead changes the transmission gaps to accommodate the update capability to monitor the entire monitoring set.

Further, 3GPP2000 discloses measurement configuration based upon *previously* received capability information, whereas applicants' amended independent claims determine measurement update frequency *during* carrier measurement. Support for this can be found in the specification on page 12 lines 16 to 17. Specifically, 3GPP2000 relates the base station download of initial capability information during call setup (see page 16 Flows 2 and 3). In contrast, applicant's amended independent claims refers to determining the characteristic *when* measuring (page 12 lines 16 to 17), even during a call (page 12 lines 25 to 26). As a result, applicants' invention provides dynamic updates of performance characteristics (page 13 lines 3 to 6) as opposed to the static approach of 3GPP2000. In view of the above, applicant respectfully submits that 3GPP2000 specifically teaches away from applicant's invention.

As a result, applicants submit that the cited references, in combination or alone, are missing at least the elements of: a) frequency of measurement updates, b) dynamic updates, c) frequency update capability instead of compressed mode capability for a single-mode user, d) selecting a subset of carrier frequencies, and e) selecting a subset of carrier frequencies based upon update capability.

Therefore, applicants respectfully submit that claims 5-10, 14, 18-22 and 29-33 are non-obvious over the cited references.

Moreover, claims 5-10 and 14 are dependent on amended claim 1, previously distinguished, and therefore includes all the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed allowable as well for the same reasons.

Similarly, claims 18-22 are dependent on amended claim 15, previously distinguished, and therefore include all the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed allowable as well for the same reasons.

Similarly, claims 29-33 are dependent on claim 27, and therefore include all of the recitations thereof, which are not disclosed or suggested by the references, and are therefore deemed allowable as well for the same reasons.

Accordingly, it is respectfully submitted that this rejection has been overcome.

The other references of record have been reviewed and applicant's invention is deemed patentably distinct and nonobvious over each taken alone or in combination.

For the foregoing reasons, applicants respectfully request that the above rejections be withdrawn.

Inasmuch as this amendment distinguishes all of the applicants' claims over the prior art references, for the many reasons indicated above, passing of this case is now believed to be in order. A Notice of Allowance is earnestly solicited.

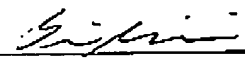
No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicants' attorney at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection or through an Examiner's amendment.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 50-2117.

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